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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/728,783	11/30/2000	Jurgen Pingel	P-4582	2695

7590 07/07/2005

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EXAMINER

WONG, LESLIE

ART UNIT	PAPER NUMBER
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2167

DATE MAILED: 07/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/728,783

Applicant(s)

PINGEL ET AL.

Examiner

Leslie Wong

Art Unit

2167

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 June 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

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Continuation of 11. does NOT place the application in condition for allowance because: the combination of Nurse and Amro would arrive at Applicant's invention. Applicant argues that Nurse taught that the items were stored in the database 5, which teaches away from storage in a data file. Therefore, the characterization of Nurse in this portion of the rejection as failing to explicitly teach where the various items are stored demonstrates that Nurse was not considered as a whole as required by the MPEP.

In reponse to the preceding arguments, Examiner respectfully submits that Nurse's database is considered to be equivalent with Applicant's data file in that their usage is similar: storing information. Further, Applicant's claimed limitation recites "entering user inputted text data for said computer-readable document in a data file" does not require the Office to show where the various items are stored. Examiner submits that Nurse col. 2, lines 18-23 and col. 1, lines 41-51 teaches the limitation as claimed. Applicant is reminded that in order to disqualify a reference based on a "teach away" reasoning, the reference has to explicitly suggest or disclose the so-called teach away steps - Applicants assertion can not be accepted if it is unsupported by a valid evidence.

Further, Applicant argues that the primary reference not only does not teach the desirability of the modification, but also the primary reference teaches away from the modification. The very motivation relied upon by the Examiner was the propose of Nurse's system and so cannot provide a motivation to modify Nurse. Thus, according to the MPEP, a prima facie obviousness basis for the rejection has not been established.

In response to the preceding arguments, Examiner respectfully submits that the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art. In this case, Nurse does not explicitly teach storing the reference database, said user inputted text data, and other data of the computer-readable document in said data file.

Amro, however, teaches 'storing the reference database, said user inputted text data, and other data of the computer-readable document in said data file' as a compound document contains multiple objects capable of running within the document, such as a spreadsheet (i.e., database), text, and hotlinks etc...(col. 4, lines 4-7 and Fig. 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of the cited references because Amro's teaching would have allowed Nurse's to ensure that all reference related data is available for access by binding separate documents together can create a well organized, coherent collection of information as suggested by Kanerva at col. 1, lines 15-18.



Leslie Wong
Patent Examiner
Art Unit 2167